Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 2002P03695WOUS

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number	Filed
10/528,730	2005-03-22

First Named Inventor: Oliver Brasse

Art Unit	Examiner
2614	Elahee, MD S

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☐ attorney or agent of record. Registration number _____.
- ☑ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 55179

/Ralph G. Fischer/
Signature

Ralph G. Fischer
Typed or printed name

412-392-2121
Telephone number

2010-10-26
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

In the Office Action of August 3, 2010, the Examiner reopened prosecution in response to an Appeal Brief filed on March 29, 2010. The only "new art" relied upon by the Examiner is U.S. Patent No. 6,970,926 to Needham et al. The Examiner relies on Needham et al. to show a call server that has a CPU and memory connected thereto. The call server disclosed by Needham et al. is a coordinator and arbitrator for dispatch group calls. (Needham et al., Abstract).

The pending claims were rejected by the Examiner in view of U.S. Patent Application Publication No. 2002/0136384, to McCormack et al., the Needham et al. reference, and U.S. Patent No. 4,370,743 to Moran.

A. Claims 14-23, 25-26, and 31-33 are Allowable

The combination of McCormack et al., Needham et al. and Moran do not teach or suggest the limitations of the pending claims 1-25 and 27-33. All of the claims require sound sequences to be stored on working memory of a PBX's CPU. Neither McCormack et al., Needham et al. nor Moran teach, suggest or otherwise disclose a PBX that includes digital sound sequences stored on working memory of the PBX's CPU or a switch device configured to transmit the digital sound sequences stored on the working memory of a PBX's CPU while the connection request of one or more communication terminals is being held. The combination of these references also does not teach or suggest such a limitation.

1. The Cited art Does not Teach or Suggest a TSA as Required by Claims 14-17 and 31-32

The Examiner correctly found that McCormack et al. do not teach or suggest a TSA nor a FIFO shift register. (Office Action of August 3, 2010, at 6). The Examiner has contended that Moran teaches or suggests a TSA or a FIFO. However, Moran does not teach or suggest a TSA or a FIFO as required by the pending claims.

Claim 14 depends from claim 12 and requires a PBX to include a TSA that is connected to a CPU. The TSA is configured to assign the digital sound sequences to programmed timeslots. Claim 16 depends from claim 14.

Claim 15 depends from claim 12 and requires a PBX to include a TSA that is configured to access the working memory and assign digital sound sequences to programmed time slots. Claim 17 depends from 15.

Claim 31 requires a PBX to include a TSA that has a FIFO shift register configured to support a packet-by-packet data transfer of digital sound sequences transmitted from the working memory of the PBX's CPU. Claim 32 requires a TSA to access working memory of a CPU to be configured to assign the digital sound sequences to programmed timeslots.

Moran does not disclose a PBX that includes a TSA configured to assign digital sound sequences to programmed time slots nor a TSA that is configured to access a working memory and assign sound sequences to programmed time slots. Moran discloses a multimode time division switching system that is configured to transmit sound to a terminal when the terminal is found to have a phone off its hook or if a digit is dialed by a subscriber. (Moran, Col. 5, lines 31-67 and Col. 6, lines 1-29). Moran does not teach or suggest a TSA that is connected to the CPU of a PBX such that the TSA can access the working memory of a CPU to assign programmed time slots to sound sequences that are outputted while a connection request is being held by the PBX.

Further, as discussed above, McCormack et al. do not teach or suggest a PBX that has a CPU with working memory that is configured to transmit the sound sequences in its working memory to a terminal that has its connection request being held. The combination of Moran,

Needham et al. and McCormack et al. do not teach each and every limitation of claims 14-17 or 31-32. These claims are allowable over the cited art.

2. The Cited art Does not Disclose a TSA as Required by Claim 23 and Claim 33

Claim 23 requires a CPU to request a microcontroller to set a start address of a digital sound sequence in the FIFO shift register of the TSA and to set a destination address in the working memory for recording sound sequences. Claim 33 requires a TSA to include a microcontroller configured to set a start address in the FIFO shift register of a TSA for recording sound sequences.

The Examiner correctly found that Moran did not teach or suggest recording of sound sequences. (Office Action of August 3, 2010, at 9). However, the Examiner found McCormack et al. taught recording of sound sequences at paragraphs 59, 61-62, 69-71, 73, 76 and 78. (Office Action of August 3, 2010, at 9-10). To the contrary, McCormack et al. only teach or suggest transmitting sound sequences to a terminal that is having it connection request held. There is no teaching or suggestion of recording sound sequences to the working memory of a PBX. Nor is there any suggestion of using a TSA and a microcontroller of a PBX to record sound sequences.

Moran does not teach or suggest any recording of any sound sequences nor the setting of a start address in a FIFO shift register by a microcontroller of a PBX to record sound sequences. McCormack et al. and Needham et al. also do not teach or suggest such requirements. Therefore, the combination of Moran, Needham et al., and McCormack et al. do not teach or suggest these limitations. Claims 23 and 33 are allowable over the cited art.

B. McCormack et al. Teach Away From Limitations of the Claims

McCormack et al. teach away from a PBX that includes a CPU that has working memory that has sound sequences stored in the working memory. Indeed, McCormack et al. require a PBX to include a separate MOH server built into the PBX, which requires a separate MOH processor and memory for the MOH server. (McCormack et al., at ¶ 78). Requiring separate CPUs and separate working memory for the PBX and MOH services is contrary to the requirements of the pending claims.

Indeed, McCormack et al. teach the opposite of the pending claims. The claims require a PBX to be configured to have a CPU and working memory that are configured to provide MOH services while also providing PBX services. McCormack et al. require separate servers with separate CPUs and working memory to provide such services.

1. The Elimination of the Built in MOH Server of McCormack et al. Shows the Pending Claims are not Rendered Obvious

An invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge,* 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01.

McCormack et al. require a PBX to include a separate MOH server built into a PBX to provide MOH services. (McCormack et al., at ¶ 78). The separate MOH server includes its own central processor, microcontrollers and memory. (*Id.* at ¶¶ 17, 63-64, 77-78). As noted in the specification of the present application, a separate MOH server is not required by the PBX of the pending claims, such as an IP-PBX or other PBX. Indeed, the separate hardware and other components of a MOH server is eliminated as necessary components by the configuration of the CPU and working memory of the PBX as required in the pending claims. (*See* Specification, at

page 2, lines 18-25, page 6, lines 18-23, page 12, lines 20-27). The elimination of the expensive hardware features of the MOH server with the retention of their function is an indicia of nonobviousness and shows that McCormack et al. do not render the pending claims obvious. (*See e.g.* Specification, at page 3, lines 17-25, page 6, lines 18-23, and page 12, lines 20-27).

C. The Needham et al. Reference Teaches Away From The Claims

The Needham et al. reference teaches that a separate server is needed to coordinate or arbitrate group calls. The claims require a PBX to be configured to have a CPU and working memory that are configured to provide MOH services while also providing PBX services. Needham et al. require the use of a separate server to perform call coordination services. This teaches away from the pending claims and toward a need for use of separate server components to perform different functionality for call administration.

As noted above, an invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge,* 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01. The elimination of the expensive hardware features of a separate MOH server with the retention of its function is an indicia of nonobviousness and shows that cited art does not render the pending claims obvious. (*See e.g.* Specification, at page 3, lines 17-25, page 6, lines 18-23, and page 12, lines 20-27).